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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,815	04/20/2000	Steven G. Goldstein	50N3483/1333	4648

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EXAMINER	
WALLERSON, MARK E	
ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/552,815	GOLDSTEIN ET AL.	
	Examiner	Art Unit	
	Mark E. Wallerson	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *30 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-56 and 58-69* is/are rejected.

7)☐ Claim(s) *57* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **1/30/2004.**

2. This application has been reconsidered. Claims 1-69 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 48, 60, and 62-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure in the original of reviewing the image data for transmission errors. If Applicant believes this rejection to be in error, Applicant is requested to provide specific support for this subject matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 48, it is unclear to the Examiner where the customer account information is being attached – in the image pump or at the image source. If the customer information is being attached at the image pump, it is unclear how this could be done without a processor.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 2, 3, 5, 6, 11, 12, 13, 14, 15, 16, 17, 22, 23, 24, 25, 26, 28, 29, 34, 35, 36, 37, 38, 39, 40, 45, 46, 47, 51, 52, 53, 54, 66, 67, 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Bell et al (Bell) (U. S. 6,147,742).

With respect to claims 1, 3, 5, 12, 15, 22, 23, 24, 26, 28, 35, 38, 45, 46, 51, 66, 67, 68 Bell discloses a system (figure 1) for transferring image data to a service provider (40) comprising an image source (camera 26) configured to provide the image data; and an image pump (which reads on the order manager) (22) configured to receive image data from the image source (column 3, lines 60-67) by a hard-wired connection (net), and responsively provide the image data to the service provider (the abstract), the image pump implemented separately from the image source (26) and the service provider (40) in a non-integral manner (figure 1) for transferring the image data from the image source to the service provider (the abstract and column 3, lines 60-62); the image pump being implemented without an internal processor or video display (figure 1) (there is no indication in Bell that the order manager contains a processor or video display), and a user signals the image pump to transfer data (column 5, lines 1-32).

With respect to claims 2 and 25, Bell discloses a photofinishing system wherein audio data is coupled with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17).

With regard to claims 6, 11, 29, and 34, Bell discloses the data source stores the data on removable storage (column 3, line 60 to column 4, line 3).

With respect to claims 13, 16, 36, and 39, Bell discloses the image pump configures the data to conform to a format required by the service provider (column 2, lines 30-38).

With regard to claims 14, 17, 37, 40, and 47, Bell discloses the image pump includes customer information that is communicated to the service provider (column 5, lines 1-11).

With respect to claim 52, Bell discloses a photofinishing system wherein audio data is coupled with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17).

With respect to claim 53, Bell discloses source transfer means (the order manager) external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider (column 4, line 42 to column 5, line 60).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Enomoto

With respect to claims 55 and 56, Enomoto downloading and executing an image pump manager program (processing-ordering software) (column 6, lines 10-18) allowing a user to view and select individual images to be processed (column 6, lines 44-50) and attaching specific instruction to the images (column 6, lines 44-64), and then uploading the desired images to the service provider (column 6, lines 44-50). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to give the user greater control in image selection.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 49 and 50, are rejected under 35 U.S.C. 102(e) as being anticipated by Enomoto.

With respect to claims 49 and 50, Enomoto discloses a system for transferring image data to a service provider (12), comprising an image source (20 or 21), and an image pump (which reads on computer 11) configured to receive the image data from the image source by a hard-wired connection (column 6, lines 23-32), and provide the image data to the service provider (column 6, lines 44-50), the image pump (11) being implemented separately from the image source (20 or 21).

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claims 62 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (U. S. 6,167,469).

With respect to claim 62 and 64, Safai discloses capturing image data by utilizing an image source (100); providing the image data to an image pump (figure 2) integral with the camera; converting the image data to a format compatible with the service provider (column 5, lines 28-62 and column 7, lines 14-50); attaching user defined instructions and customer account information (column 7, lines 32-50 and column 15, lines 16-27); transferring the image from the image pump to the service provider (column 2, lines 1-3); reviewing the order and providing services to the user (column 9, lines 30-45).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 4, 18, 19, 27, 41, 42 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Cok (U. S. 6,157,436).

With respect to claims 4 and 27, Bell differs from claims 4 and 27 in that he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means (column 7, lines 35-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to obtain data from different sources.

With respect to claims 18, 19, 41, and 42, Bell differs from claims 18, 19, 41, and 42 in that he does not clearly disclose a touch screen. Cok discloses an operator station comprising a CRT or LCD screen wherein an operator can use any suitable input device to enter print order information on the screen (column 8, lines 1-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein a touch screen is used to enter print information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to achieve ease of operation.

With respect to claim 54, Bell differs from claim 54 in that he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means or disk (112) and transfers the data to the photofinisher (160) by wireless, disk or cable means (column 7, lines 4-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to obtain data from different sources.

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 7, 8, 9, 10, 20, 21, 30, 31, 32, 33, 43, 44, 58, 58, 60, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Enomoto (U. S. 5,974,401).

Bell differs from claims 7, 8, 9, 10, 30, 31, 32, and 33 in that he does not clearly disclose the type of connection between the Image pump and the service provider. Enomoto discloses communicating with the service provider via a wireless (radio telephone line); hard-wired (cable); Ethernet (which reads on a network such as the Internet), or a public switched telephone network (column 3, lines 21-30 and column 4, lines 61-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein different transmission methods are user to transmit image data to the service provider. It

would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to allow the service provider to receive data from different sources.

With respect to claims 20, 21, 43, and 44, Bell differs from claims 20, 21, 43, and 44 in that he does not clearly disclose determining user selections and transferring the selections to the service provider. Enomoto discloses determining user selections and transferring the selections to the service provider (column 6, lines 44-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein user selections are determined and transferred to the service provider. It would have bee obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to achieve ease of operation.

With respect to claims 58 and 59, Bell differs from claims 58 and 59 in that he does not clearly disclose attaching customer information to the image data. Enomoto discloses attaching customer information to the data (column 3, line 64 to column 4, line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to easily identify and process the image data.

With respect to claim 60, Enomoto discloses capturing image data utilizing an image source (20 or 21); sending the image data to an image pump (11); attaching customer account information to the image data (column 3, line 64 to column 4, line 4); sending the image data and customer account information to the service provider (column 6, lines 44-50); determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7,

lines 4-8); providing services by the service provider (column 7, lines 23-40, and returning a final product to the user, along with a bill (column 7, line 41 to column 8, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to reduce errors in the image processing.

With regard to claim 61, Enomoto discloses configuring the image data to conform to a format required by the service provider (column 3, lines 41-60).

19. Claims 63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai in view of Enomoto.

With respect to claim 63, Safai differs from claim 63 in that he does not clearly disclose that the image source is a scanner. Enomoto discloses a scanner as an image source (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to vary the image sources.

With respect to claim 65, Safai discloses including customer account information (column 15, lines 17-27). Safai differs from claim 65 in that he does not disclose determining if the image data and customer information have errors, and requesting the image pump to re-transmit the image data and customer information if errors are detected. Enomoto discloses determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7, lines 4-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to improve the image system.

20. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Cok.

With respect to claim 69, Bell differs from claim 69 in that although he discloses transferring the data to the service provider in aby means of a network (figure 1), he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means or disk (112) and transfers the data to the photofinisher (160) by wireless, disk or cable means (column 7, lines 4-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to obtain data from different sources

Allowable Subject Matter

21. Claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

22. Applicant's arguments filed 8/18/2003 have been fully considered but they are not persuasive.

Applicant submits that *Bell* fails to disclose an image pump that is "implemented separately from the image source and service provider in a non-integral manner, for transferring

said image data from said image source to said service provider", and that the rejections under § 102(e) are improper. The Examiner respectfully disagrees.

Bell discloses an image pump (the Examiner submits that the order manager (22) equates to the image pump), implemented separately from the image source (26) and service provider (40), (figure 1 clearly depicts the order manager (22) implemented separately (and in a non-integral manner) from the image source (26) and the service provider), for transferring image data from the image source to the service provider (column 4, lines 25-37 and column 5, lines 1-40), and service provider being implemented to include a photofinishing system (column 3, lines 44-47). There is no indication in *Bell* that the order manager contains a processor.

In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARK WALLERSON
PRIMARY EXAMINER

Mark E. Wallerson
Primary Examiner